

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT of:

Joseph B. Thompson

Atty. Docket No.: BEAR CREEK 3R

Reexamination Serial No.: 95/002,190

Group Art Unit: 3992

Patent No. 7,889,722

Confirmation No: 4394

Issued: February 15, 2011

Examiner: TIBBITS, Pia Florence

Title: **SYSTEM FOR INTERCONNECTING STANDARD TELEPHONY COMMUNICATIONS
EQUIPMENT TO INTERNET PROTOCOL NETWORKS**

February 26, 2016

PATENT OWNER'S

NOTICE OF APPEAL TO THE

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

Mail Stop: *Inter Partes* Reexam
Attn: The Patent Trial and Appeal Board
Commissioner for Patents
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Customer No:

31704

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PATENT OWNER'S
NOTICE OF APPEAL TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Pursuant to 35 U.S.C. §§ 141 and 142, 37 C.F.R. § 1.983, and Federal Circuit Rule 15(a), the Patent Owner, Bear Creek Technologies, Inc. (“Bear Creek”) hereby appeals to the United States Court of Appeals for the Federal Circuit from the Decision on Appeal by the Patent Trial and Appeal Board (“PTAB”) in the above-captioned *Inter Partes* Reexamination of United States Patent No. 7,889,722, including without limitation the PTAB’s Decision on Appeal (Appeal No. 2015-006387), dated December 29, 2015. The issues on appeal include, without limitation, the PTAB’s decision to sustain the Examiner’s rejection of claims 1-22 of United States Patent No. 7,889,722 under 35 U.S.C. § 103(a), the PTAB’s claim construction, the PTAB’s obviousness analysis, and any other finding and/or determination decided adversely to the Petitioner relevant to these issues.

This Notice of Appeal is being filed within two (2) months from the date of the PTAB’s Decision and, therefore, is being timely filed pursuant to 35 U.S.C. § 142 and 37 C.F.R. § 1.304 (the due date being February 29, 2016).

Separately, in compliance with 37 C.F.R. § 1.983(b) and Federal Circuit Rule 15(a), one (1) copy of this Notice of Appeal and the Docketing Fee of \$500.00, as prescribed by Federal Circuit Rule 52(a)(3)(A), are being transmitted to the Clerk for the United States Court of Appeals for the Federal Circuit. Pursuant to discussions with the Clerk’s Office for the United States Court of Appeals for the Federal Circuit, the undersigned acknowledges that only one (1) copy of this Notice of Appeal (not three (3) copies, as identified in Federal Circuit Rule 15(a)(1)) is required to be submitted electronically together with the electronic payment of the Docketing Fee via the Case Management/Electronic Case Files system (“CM/ECF”).

A courtesy copy of the PTAB’s Decision on Appeal accompanies this Notice of Appeal.

In addition, a copy of suggested Form 5, identified in Federal Circuit Rule 15(a)(3), is provided herewith. As noted on Form 5, Bear Creek Technologies, Inc. is the Petitioner/Appellant for purposes of this appeal. Cisco Systems, Inc., who is the Third Party Requester in the *Inter Partes* Reexamination Proceeding, is listed as the Respondent/Appellee for purposes of this appeal.

While no other fee is believed to be due to the United States Patent and Trademark Office, if there are any fees required for this submission that are not otherwise accounted for, please charge Deposit Account No. 50-2127. In addition, please credit any overpayments to the same Deposit Account.

Respectfully submitted,

THOMAS, KARCESKI & KARMILOVICH, P.C.



Date: February 26, 2016

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the following documents:

- (1) PATENT OWNER'S NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT,**
- (2) DECISION ON APPEAL, dated December 29, 2015, by the Patent Trial and Appeal Board for Appeal No. 2015-006387 (as an attachment to this Notice of Appeal), and**
- (3) FORM 5, suggested for use by the United States Court of Appeals for the Federal Circuit to designate the parties to this Appeal (as an attachment to this Notice of Appeal)**

were filed with the United States Patent and Trademark Office, via the Electronic Filing System ("EFS"), and filed with the United States Court of Appeals for the Federal Circuit, via the Case Management/Electronic Case Files system ("CM/ECF") on February 26, 2016.

In addition, the undersigned hereby certifies that true and complete copies of the above-listed documents, together with true and complete copies of the following additional documents:

- (4) Electronic Filing Receipt from the United States Patent and Trademark Office, acknowledging receipt of this Notice of Appeal, and**
- (5) Electronic Receipt from the CM/ECF, acknowledging receipt of the Docketing Fee for the United States Court of Appeals for the Federal Circuit**

were sent by first class mail on February 26, 2016 (in accordance with M.P.E.P. §2666.06) to the address provided below:

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Respectfully submitted,

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/002,190	09/12/2012	7889722	BCT-P001USC3-R3	4394

7590 12/29/2015
Joseph B. Thompson
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EXAMINER

LEE, CHRISTOPHER E

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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12/29/2015

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.
Requester and Respondent

v.

BEAR CREEK TECHNOLOGIES, INC.
Patent Owner and Appellant

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2
Technology Center 3900

Before MARC S. HOFF, DAVID M. KOHUT, and ERIC B. CHEN,
Administrative Patent Judges.

CHEN, *Administrative Patent Judge.*

DECISION ON APPEAL

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Patent Owner Bear Creek Technologies, Inc. appeals under 35 U.S.C. § 134(b) and 35 U.S.C. § 315(a) (pre-AIA) the Examiner's final decision to reject claims 1–22.

An oral hearing was held on November 10, 2015, with both parties in attendance. The record includes a written transcript of the oral hearing.

Third-Party Requester Cisco Systems, Inc. urges that the Examiner's decision be affirmed.

We affirm.

STATEMENT OF THE CASE

U.S. Patent No. 7,889,722 B2 (“’722 patent”), entitled “System for Interconnecting Standard Telephony Communications Equipment to Internet Protocol Networks,” issued February 15, 2011 to Joseph B. Thompson, based on Application No. 11/253,129, filed October 18, 2005, which is said to be a continuation of Application No. 10/770,808, filed February 3, 2004, now U.S. Patent No. 6,985,494 B2, issued January 10, 2006, which is said to be a continuation of Application No. 10/279,645, filed October 24, 2002, now abandoned, which is said to be a continuation of Application No. 08/812,745, filed March 6, 1997, now abandoned.

The ’722 patent is also said to claim priority to provisional Application No. 60/012,896, filed on March 6, 1996 and provisional Application No. 60/013,240, filed on March 11, 1996.

The ’722 patent is assigned to Bear Creek Technologies, Inc., the real party in interest.

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Related Litigation

The '722 patent is or has been involved in numerous litigations, as summarized in Patent Owner's Appeal Brief. (PO App. Br. 1–2.)

The Claims

Independent claim 1 is exemplary, with disputed limitations in italics:

1. Apparatus comprising:

an Internet phone server capable of being in communication with an originating phone device, the originating phone device being capable of both dialing a given destination number of a given destination device and thereby initiating a given call between the originating phone device and the given destination device, an auditory dial tone being caused at the originating phone device when the originating phone device is in an off-hook state and operatively connected to the Internet phone server, the given call including transmission of transmitted media between the originating phone device and the given destination device;

a first media converter configured to convert the transmitted media for the given call received from the originating phone device, to transmitted IP addressed media;

a destination number determination mechanism configured to determine a given destination number of the given call placed by the originating phone device;

an IP versus another phone network discriminator configured to determine, after the transmitted media is converted by the first media converter to the transmitted IP addressed media, whether a given destination phone device addressed by the given destination number resides on an IP addressed network, for which the transmitted IP addressed media is converted by the first media converter, or resides on another phone network;

a second media converter configured to convert the transmitted IP addressed media of the given call to another network signal suitable for another phone network when the discriminator determines

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that the given destination number resides on the other phone network;
and

a communication mechanism configured to connect the given call over an Internet connection without converting the transmitted IP addressed media of the given call to the other network signal, when the discriminator determines that the given destination device addressed by the given destination number resides on the IP addressed network.

The Rejections

Patent Owner appeals the Examiner's decision to reject all the pending claims, as follows:

1. Claims 1–8 and 10–22 stand rejected under 35 U.S.C. § 103(a) as obvious over Baratz (US 5,742,596; Apr. 21, 1998) and Turock (US 6,243,373 B1; June 5, 2001).
2. Claim 9 stands rejected under 35 U.S.C. § 103(a) as obvious over Baratz and Turock, as evidenced by White (US 6,711,241 B1; Mar. 23, 2004).
3. Claims 1–12 and 14–22 stand rejected under 35 U.S.C. § 103(a) as obvious over Iwami (US 5,604,737; Feb. 18, 1997) and Baratz.
4. Claim 13 stands rejected under 35 U.S.C. § 103(a) as obvious over Iwami and Baratz, as evidenced by Lindgren (B. LINDGREN & LEIF JONSSON, ILLUSTRATED ISDN 1-6 to -9 (1991)).
5. Claims 1–3, 5, 6, 8–14, and 16–22 stand rejected under 35 U.S.C. § 103(a) as obvious over Jonas (US 2001/0040885 A1; Nov. 15, 2001) and Kubler (US 5,726,984; Mar. 10, 1998).
6. Claims 4 and 15 stand rejected under 35 U.S.C. § 103(a) as obvious over Jonas, Kubler, and Pepe (US 5,742,905; Apr. 21, 1998).

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7. Claim 7 stands rejected under 35 U.S.C. § 103(a) as obvious over Jonas, Kubler, and Iwami.

8. Claims 1–3, 5–14, and 16–22 stand rejected under 35 U.S.C. § 103(a) as obvious over Schindler (US 6,954,453 B1; Oct. 11, 2005), Merritt (Ian H. Merritt, *Providing Telephone Line Access to a Packet Voice Network*, Report No. ISI/RR-83-107, Information Sciences Institute, University of Southern California (1983)), and Kubler.

9. Claims 4 and 15 stand rejected under 35 U.S.C. § 103(a) as obvious over Schindler, Merritt, Kubler, and Pepe.

§ 103 Rejection—Iwami and Baratz

Claims 1–3, 5–10, 12, 14–17, and 19–22

The Examiner found that the communication server of Iwami, which determines whether the address input by a user is directed towards a communication terminal address or a telephone number, corresponds to the limitation “an IP versus another phone network discriminator.” (RAN 47–48, 102–103.) Requester agrees and argues that “Iwami discloses generally that a communication server 20 acts as a discriminator” and “determines whether an address of a called party is a communication terminal 10 on a LAN 1 or a telephone 2 on a public network 3.” (Requester Resp. Br. 11.) We agree with the Examiner’s determination.

Iwami relates to a voice communication system, in particular, “communication terminals connected through a communication network.” (Col. 1, ll. 6–8.) Figure 1 of Iwami illustrates a voice communication system, including communication terminals 10-1, 10-2 connected to Local

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Area Network (LAN) 1 and telephone 2 connected to public network 3, such that LAN 1 and public network 3 are connected simultaneously to communication server 20. (Col. 7, ll. 1–8.) Iwami explains that “[t]he communication server [20] determines whether an address of the other party inputted by a user is a communication terminal address or a telephone number.” (Abstract.) Figure 5 of Iwami illustrates voice communication control processing performed by voice communication program 31 (col. 9, ll. 12–14) including “Step 124” in which “program 31 determines . . . whether or not the address of the other party with whom the user desires to speak is a telephone number consisting only of a sequence of numeric characters” (col. 9, ll. 29–33) such that “the user has requested a voice communication with a telephone 2 connected to the external public network 3” (col. 9, ll. 36–38). Otherwise, Iwami explains that “if the address of the other party inputted by the user is not a telephone number . . . the address of the other party can be regarded as the address of a communication terminal on the LAN 1.” (Col. 9, ll. 45–49.) Because communication server 20 of Iwami determines if the address of the other party is connected either through LAN 1 or public network 3, Iwami teaches the limitation “an IP versus another phone network discriminator.”

Patent Owner argues that “Iwami does not describe at least an IP versus another phone network discriminator.” (PO App. Br. 18.) In particular, Patent Owner argues that

Iwami describes how, at step 124, if the address of the other party (*i.e.*, the receiving party) is a telephone number consisting only of a sequence of numeric characters, this means that that the user (*i.e.*, the calling party) has requested a voice

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communication with a telephone 2 connected to the external public network 3 through [the] communication server 20. (*Id.*; *see also* PO Reb. Br. 4.) Accordingly, Patent Owner argues, “[t]he user’s input of the numeric characters provides the information utilized by the communication server 20.” (*Id.* (emphasis omitted).) However, the claim language “an IP versus another phone network discriminator” is broad enough to encompass communication server 20 of Iwami, having program 31 which discriminates between a telephone number and an address for a terminal.

Patent Owner also argues “Iwami describes a system that . . . requires the user to discriminate between telephone or Internet lines” and accordingly, “Iwami teaches away from claims 1–12 and 14–22.” (PO App. Br. 18.) However other than providing a conclusory statement that Iwami teaches away from the claimed invention, Patent Owner does not provide any persuasive arguments as to how Iwami criticizes, discredits, or otherwise discourages the claimed “IP versus another phone network discriminator.” *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Accordingly, we sustain the rejection of claims 1–3, 5–10, 12, 14–17, and 19–22 under 35 U.S.C. § 103(a).

Claim 4

The Examiner found that the fax component of Baratz corresponds to the limitation “wherein the originating phone device includes standard fax equipment,” as recited in dependent claim 4. (RAN 52 (citing RAN 22).) Requester agrees and argues that “Baratz discloses that the components shown coupled to system 10 may be implemented on the same host

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computers or may be distributed throughout the network, indicating that the fax component 24 may be implemented within system 10 as an embodiment of Baratz.” (Requester Resp. Br. 14.) We agree with the Examiner’s determination.

Baratz “relates to a network based distributed Private Branch Exchange (PBX) system.” (Col. 1, ll. 5–6.) Figure 1 illustrates system 10, including telephony servers 44 for managing all system control processes (col. 4, ll. 8–10) and regular telephone sets 42 (col. 5, ll. 18–19). Figure 2 of Baratz illustrates system 10 coupled with automatic message distribution system 30 that delivers fax transmissions through fax component 24. (Col. 8, ll. 6–9.) Baratz explains the following:

The components/functions shown coupled to system **10** may be implemented on the same or different host computers. They do not necessarily have to be integral with the telephony server module but may be distributed throughout the network.

(Col. 7, ll. 6–10.) Because Baratz explains that fax component 24 can be distributed throughout the network, which includes coupling with regular telephone sets 42, Baratz teaches the limitation “wherein the originating phone device includes standard fax equipment.”

Patent Owner argues that “fax 24 and the automatic message distribution 30 are **not a part** of the system 10 or the network 37 within the system 10.” (PO App. Br. 19.) However, as discussed previously, Baratz explains that fax component 24 can be distributed throughout the network. (See col. 7, ll. 6–10.) Furthermore, Patent Owner’s arguments are not commensurate in scope with claim 11, because the claim does not expressly recite a location for the standard fax equipment.

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Accordingly, we sustain the rejection of claim 4 under 35 U.S.C. § 103(a).

Claim 11

The Examiner found that the telephony server of Baratz, which is connected to Internet services, corresponds to the limitation “wherein the Internet phone server includes the destination number determination mechanism.” (RAN 55 (citing RAN 25).) Requester agrees and argues “Baratz says that a database in telephony server 44 is used ‘to support internal *and external* call capability’ . . . and that ‘network addresses (i.e. physical extensions) for both parties are retrieved from telephony server 44’ for both internal and external calls.” (Requester Reb. Br. 14.) We agree with the Examiner’s determination.

As discussed previously, Figure 1 of Baratz illustrates system 10, including telephony servers 44 for managing all system control processes. (Col. 4, ll. 8–10.) Baratz explains that “[t]o support internal and external call capability, telephony server **44** maintains a database of user records,” for example, an extension number. (Col. 6, ll. 16–19.) Because telephony server 44 includes a database of user records for making calls, Baratz teaches the limitation “wherein the Internet phone server includes the destination number determination mechanism.”

Patent Owner argues that “the Examiner incorrectly equated the database used to locate the computers 40 and the telephone sets 42 on the network 37 with the destination number determining mechanism that operates.” (PO App. Br. 19.) However, Patent Owner’s arguments are not

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commensurate in scope with claim 11, because the claim does not exclude the claimed destination number determination mechanism from being stored on a network.

Accordingly, we sustain the rejection of claim 11 under 35 U.S.C. § 103(a).

Claim 18

The Examiner found that the voice communication server program on the communication server of Iwami corresponds to the limitation “wherein the Internet phone server comprises both a call receipt portion and a call delivery portion, and wherein the call delivery portion includes the discriminator.” (RAN 56–57.) Requester agrees and argues “[t]he communication server program clearly performs the functions of call receipt, for example accepting call requests from both telephones and communications terminals, and call delivery, for example transmitting voice packets to communication terminals and transmitting voice information to telephones.” (Requester Reb. Br. 14–15.) We agree with the Examiner’s determination.

Iwami explains that communication server 20 stores a voice communication server program 22 for voice communication control processing. (Col. 10, l. 66 to col. 11, l. 1.) Iwami further explains that:

The voice communication server program **22** is a program for accepting a call setting request from a telephone received from the public network communication controller **21** or a voice communication request from a communication terminal through the LAN communication controller **14** connected to the internal bus **19**, editing voice packets

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transmitted from the telephone into voice packets, transmitting the voice packets to the communication terminal, converting voice packets received from the communication terminal to voice information, and transmitting the voice information to the telephone, thus providing voice communication functions between the communication terminal connected to the LAN 1 and the telephone connected to the public network 3, similar to the conventional functions between telephones.

(Col. 11, ll. 4–17.) Because voice communication server program 22 of Iwami is stored on communication server 20 and provides voice communication functions between telephone 2 (connected to public network 3) and communication terminals 10-1, 10-2 (connected to LAN 1), Iwami teaches the limitation “wherein the Internet phone server comprises both a call receipt portion and a call delivery portion, and wherein the call delivery portion includes the discriminator.”

Patent Owner argues that “Iwami does not provide any discussion of the elements recited by claim 18.” (PO App. Br. 20.) However, other than making a conclusory statement, Patent Owner has not provided a sufficient explanation as to why dependent claim 18 is patentable over the combination of Iwami and Baratz.

Accordingly, we sustain the rejection of claim 18 under 35 U.S.C. § 103(a).

§ 103 Rejection—Iwami, Baratz, and Lindgren

Although Patent Owner nominally argues the rejection of dependent claim 13 separately (PO App. Br. 20), the arguments presented do not point out with particularity or explain why the limitations of this dependent claim is separately patentable. Instead, Patent Owner summarily alleges that

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“there is nothing in Lindgren that may be said to describe or suggest, among other things, an apparatus including an apparatus including IP versus another phone network discriminator” and “[g]iven that Lindgren does not cure the deficiencies noted with respect to Iwami and Baratz, the combination of Lindgren with Iwami and Baratz cannot be said to render obvious claim 13.” (*Id.*) We are not persuaded by these arguments for the reasons discussed with respect to claim 1, from which claim 13 depends. Accordingly, we sustain this rejection.

Other § 103 Rejections

We do not reach the additional cumulative rejections of claims 1–22 under 35 U.S.C. § 103(a) as obvious over various combinations of Baratz, Turock, White, Jonas, Kubler, Pepe, Iwami, Schindler, and Merritt. Affirmance of the obviousness based rejections discussed previously renders it unnecessary to reach the remaining obviousness rejections, as all of pending claims have been addressed and found unpatentable.

DECISION

The Examiner’s decision to reject claims 1–22 under U.S.C. § 103(a) is affirmed.

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. § 1.956. *See* 37 C.F.R. § 41.79.

AFFIRMED

mls

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

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FORM 5. Petition for Review or Notice of Appeal of an Order or Decision of an AGENCY, BOARD, COMMISSION, OFFICE OR BUREAU.

United States Court of Appeals for Federal Circuit

Bear Creek Technologies, Inc.,

Petitioner or Appellant,

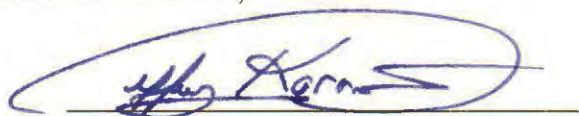
v.

PETITION FOR REVIEW

Cisco Systems, Inc.,

Respondent or Appellee.

Bear Creek Technologies, Inc. (name all parties* bringing the petition or appeal) hereby petition/appeal the court for review of the Decision on Appeal (No. 2015-6387) (describe the order or decision and include decision number) of the Patent Trial and Appeal Board (name the agency, board, office or bureau) entered on December 29, 2015 (date). The order or decision was received on December 29, 2015 (date).



(Signature of petitioner, appellant or attorney)

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(Address and phone number of petitioner, appellant or attorney)

*See Fed. R. App. P. 15 for permissible ways of identifying petitioners.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BEAR CREEK TECHNOLOGIES, INC.
Owner/Appellant

v.

CISCO SYSTEMS, INC.
Requester/Appellee

Re-Exam Control No: 95/002,190

NOTICE FORWARDING CERTIFIED LIST

A Notice of Appeal to the United States Court of Appeals for the Federal Circuit was timely filed on February 26, 2016, in the United States Patent and Trademark Office in connection with the above identified *inter partes* re-examination proceeding. Pursuant to 35 U.S.C. § 143, and Fed. Cir. R. 17(b)(1), a Certified List is this day being forwarded to the Federal Circuit.

Respectfully submitted,

By: Tawana A. Hawkins

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571-272-9035

Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent and Trademark Office

Date: April 6, 2016

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing has been served on Appellant and Appellee this 6th day of April 2016, as follows:

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By:



Tawana A. Hawkins

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Form PTO 55 (12-80)

**U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office**

April 6, 2016

(Date)

THIS IS TO CERTIFY that the attached document is a list of the papers that comprise the record before the Patent Trial and Appeal Board (PTAB) for the *Inter Partes Reexamination* proceeding identified below:

BEAR CREEK TECHNOLOGIES, INC.
Patent Owner

v.

CISCO SYSTEMS, INC.
Third Party Requester

Appeal 2015-006387
Reexamination Control No. 95/002,190
Patent 7,889,722

By authority of the

**DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Lawrence A. Harkness

Certifying Officer



**PROSECUTION HISTORY OF BEAR CREEK TECHNOLOGIES, INC. v. CISCO
SYSTEMS, INC.
REEXAMINATION NO. 95/002,190**

DATE	DOCUMENT
09/12/2012	Request for <i>Inter Partes</i> Reexamination
09/24/2012	Patent Assignment Abstract of Title
09/28/2012	Patent Assignment Abstract of Title and Litigation Search Report
10/01/2012	Notice of Assignment of <i>Inter Partes</i> Reexamination Request and Notice of <i>Inter Partes</i> Reexamination Request Filing Date
11/28/2012	Order Granting Request for <i>Inter Partes</i> Reexamination
01/23/2013	BIB Data Sheet
03/25/2013	Notice Regarding Change of Power of Attorney and Notice of Acceptance of Power of Attorney
03/26/2013	Office Action
05/28/2013	Patent Owner Exhibit 1, Response to Office Action Dated March 26, 2013
06/26/2013	Comments by Third Party Requester
07/01/2013	Information Disclosure Statement (IDS)
03/24/2014	Action Closing Prosecution
04/21/2014	Request for two Month Extension of Time
04/24/2014	Patent Owner Comments After Action Closing Prosecution Dated March 24, 2014
04/25/2014	Decision on Petition for Extension of Time
05/22/2014	Comments By Third Party Requester to ACP
08/15/2014	Right of Appeal Notice
09/15/2014	Notice of Appeal
11/14/2014	Patent Owner Exhibits
12/02/2014	Errata for Appeal Brief
12/12/2014	Exhibits
12/23/2014	Notification re: Brief
12/31/2014	Third Party Requester's Amended Respondent Brief
02/10/2015	Pacer Report for Bear Creek Technologies v. Verizon Services Corp.
04/15/2015	Examiner's Answer
05/15/2015	Rebuttal Brief
05/27/2015	Acknowledgement of Patent Owner's Rebuttal Brief
05/29/2015	Request for Oral Hearing
06/24/2015	Patent Trial and Appeal Board Docketing Notice
09/25/2015	Notice of Hearing
10/05/2015	Acknowledgement of Notice of Hearing

**PROSECUTION HISTORY OF BEAR CREEK TECHNOLOGIES, INC. v. CISCO
SYSTEMS, INC.****REEXAMINATION NO. 95/002,190**

10/07/2015	Acknowledgement of Notice of Hearing
11/17/2015	Decision Request to Withdraw as Attorney/Agent Record
11/18/2015	Notice Regarding Change of Power of Attorney
12/21/2015	Oral Argument Held November 10, 2015
12/22/2015	Power of Attorney
12/29/2015	Decision on Appeal
01/04/2016	Notice of Acceptance of Power of Attorney
02/26/2016	Patent Owner's Notice of Appeal
03/04/2016	Third Party Requester's Notice of Election to Participate in Patent Owner's Appeal

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT of:

Joseph B. Thompson

Atty. Docket No. BEAR CREEK 3R

Reexamination Serial No.: 95/002,190

Group Art Unit: 3992

Patent No. 7,889,722

Confirmation No: 4394

Issued: February 15, 2011

Examiner: TIBBITS, Pia Florence

Title: **SYSTEM FOR INTERCONNECTING STANDARD TELEPHONY COMMUNICATIONS
EQUIPMENT TO INTERNET PROTOCOL NETWORKS**

February 26, 2016

PATENT OWNER'S
NOTICE OF APPEAL TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Mail Stop: *Inter Partes* Reexam
Attn: The Patent Trial and Appeal Board
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

Customer No:

31704

Atty. Dkt. No.: BEAR CREEK 3R

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PATENT OWNER'S
NOTICE OF APPEAL TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Pursuant to 35 U.S.C. §§ 141 and 142, 37 C.F.R. § 1.983, and Federal Circuit Rule 15(a), the Patent Owner, Bear Creek Technologies, Inc. ("Bear Creek") hereby appeals to the United States Court of Appeals for the Federal Circuit from the Decision on Appeal by the Patent Trial and Appeal Board ("PTAB") in the above-captioned *Inter Partes* Reexamination of United States Patent No. 7,889,722, including without limitation the PTAB's Decision on Appeal (Appeal No. 2015-006387), dated December 29, 2015. The issues on appeal include, without limitation, the PTAB's decision to sustain the Examiner's rejection of claims 1-22 of United States Patent No. 7,889,722 under 35 U.S.C. § 103(a), the PTAB's claim construction, the PTAB's obviousness analysis, and any other finding and/or determination decided adversely to the Petitioner relevant to these issues.

This Notice of Appeal is being filed within two (2) months from the date of the PTAB's Decision and, therefore, is being timely filed pursuant to 35 U.S.C. § 142 and 37 C.F.R. § 1.304 (the due date being February 29, 2016).

Separately, in compliance with 37 C.F.R. § 1.983(b) and Federal Circuit Rule 15(a), one (1) copy of this Notice of Appeal and the Docketing Fee of \$500.00, as prescribed by Federal Circuit Rule 52(a)(3)(A), are being transmitted to the Clerk for the United States Court of Appeals for the Federal Circuit. Pursuant to discussions with the Clerk's Office for the United States Court of Appeals for the Federal Circuit, the undersigned acknowledges that only one (1) copy of this Notice of Appeal (not three (3) copies, as identified in Federal Circuit Rule 15(a)(1)) is required to be submitted electronically together with the electronic payment of the Docketing Fee via the Case Management/Electronic Case Files system ("CM/ECF").

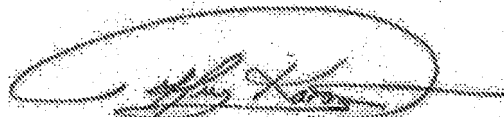
A courtesy copy of the PTAB's Decision on Appeal accompanies this Notice of Appeal.

In addition, a copy of suggested Form 5, identified in Federal Circuit Rule 15(a)(3), is provided herewith. As noted on Form 5, Bear Creek Technologies, Inc. is the Petitioner/Appellant for purposes of this appeal. Cisco Systems, Inc., who is the Third Party Requester in the *Inter Partes* Reexamination Proceeding, is listed as the Respondent/Appellee for purposes of this appeal.

While no other fee is believed to be due to the United States Patent and Trademark Office, if there are any fees required for this submission that are not otherwise accounted for, please charge Deposit Account No. 50-2127. In addition, please credit any overpayments to the same Deposit Account.

Respectfully submitted,

THOMAS, KARCESKI & KARMILOVICH, P.C.



Date: February 26, 2016

By: _____

Jeffrey D. Karceski
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Tel No. 202-349-9868
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1717 K Street, N.W., Suite 900
Washington, D.C. 20006
Customer Number: **31704**

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the following documents:

- (1) **PATENT OWNER'S NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT,**
- (2) **DECISION ON APPEAL**, dated December 29, 2015, by the Patent Trial and Appeal Board for Appeal No. 2015-006387 (as an attachment to this Notice of Appeal), and
- (3) **FORM 5**, suggested for use by the United States Court of Appeals for the Federal Circuit to designate the parties to this Appeal (as an attachment to this Notice of Appeal)

were filed with the United States Patent and Trademark Office, via the Electronic Filing System ("EFS"), and filed with the United States Court of Appeals for the Federal Circuit, via the Case Management/Electronic Case Files system ("CM/ECF") on February 26, 2016.

In addition, the undersigned hereby certifies that true and complete copies of the above-listed documents, together with true and complete copies of the following additional documents:

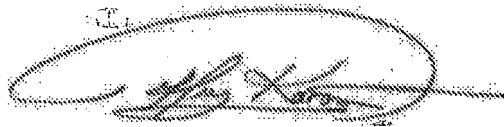
- (4) **Electronic Filing Receipt from the United States Patent and Trademark Office, acknowledging receipt of this Notice of Appeal, and**
- (5) **Electronic Receipt from the CM/ECF, acknowledging receipt of the Docketing Fee for the United States Court of Appeals for the Federal Circuit**

were sent by first class mail on February 26, 2016 (in accordance with M.P.E.P. §2666.06) to the address provided below:

David L. McCombs
Haynes and Boone, LLP
2323 Victory Avenue, Suite 700
Dallas, Texas 75219

Respectfully submitted,

THOMAS, KARCESKI & KARMILOVICH, P.C.



Date: February 26, 2016

By:

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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/002,190	09/12/2012	7889722	BCT-P001USC3-R3	4394

7590
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 25910 Canal Road
 Box 0-136
 Orange Beach, AL 36561

12/29/2015

EXAMINER

LEE, CHRISTOPHER B

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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12/29/2015

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.
Requester and Respondent

v.

BEAR CREEK TECHNOLOGIES, INC.
Patent Owner and Appellant

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2
Technology Center 3900

Before MARC S. HOFF, DAVID M. KOHUT, and ERIC B. CHEN,
Administrative Patent Judges.

CHEN, *Administrative Patent Judge.*

DECISION ON APPEAL

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

Patent Owner Bear Creek Technologies, Inc. appeals under 35 U.S.C. § 134(b) and 35 U.S.C. § 315(a) (pre-AIA) the Examiner's final decision to reject claims 1--22.

An oral hearing was held on November 10, 2015, with both parties in attendance. The record includes a written transcript of the oral hearing.

Third-Party Requester Cisco Systems, Inc. urges that the Examiner's decision be affirmed.

We affirm.

STATEMENT OF THE CASE

U.S. Patent No. 7,889,722 B2 ("722 patent"), entitled "System for Interconnecting Standard Telephony Communications Equipment to Internet Protocol Networks," issued February 15, 2011 to Joseph B. Thompson, based on Application No. 11/253,129, filed October 18, 2005, which is said to be a continuation of Application No. 10/770,808, filed February 3, 2004, now U.S. Patent No. 6,985,494 B2, issued January 10, 2006, which is said to be a continuation of Application No. 10/279,645, filed October 24, 2002, now abandoned, which is said to be a continuation of Application No. 08/812,745, filed March 6, 1997, now abandoned.

The '722 patent is also said to claim priority to provisional Application No. 60/012,896, filed on March 6, 1996 and provisional Application No. 60/013,240, filed on March 11, 1996.

The '722 patent is assigned to Bear Creek Technologies, Inc., the real party in interest.

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

Related Litigation

The '722 patent is or has been involved in numerous litigations, as summarized in Patent Owner's Appeal Brief. (PO App. Br. 1-2.)

The Claims

Independent claim 1 is exemplary, with disputed limitations in italics:

1. Apparatus comprising:
 - an Internet phone server capable of being in communication with an originating phone device, the originating phone device being capable of both dialing a given destination number of a given destination device and thereby initiating a given call between the originating phone device and the given destination device, an auditory dial tone being caused at the originating phone device when the originating phone device is in an off-hook state and operatively connected to the Internet phone server, the given call including transmission of transmitted media between the originating phone device and the given destination device;
 - a first media converter configured to convert the transmitted media for the given call received from the originating phone device, to transmitted IP addressed media;
 - a destination number determination mechanism configured to determine a given destination number of the given call placed by the originating phone device;
 - an IP versus another phone network discriminator* configured to determine, after the transmitted media is converted by the first media converter to the transmitted IP addressed media, whether a given destination phone device addressed by the given destination number resides on an IP addressed network, for which the transmitted IP addressed media is converted by the first media converter, or resides on another phone network;
 - a second media converter configured to convert the transmitted IP addressed media of the given call to another network signal suitable for another phone network when the discriminator determines

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

that the given destination number resides on the other phone network;
and

a communication mechanism configured to connect the given call over an Internet connection without converting the transmitted IP addressed media of the given call to the other network signal, when the discriminator determines that the given destination device addressed by the given destination number resides on the IP addressed network.

The Rejections

Patent Owner appeals the Examiner's decision to reject all the pending claims, as follows:

1. Claims 1-8 and 10-22 stand rejected under 35 U.S.C. § 103(a) as obvious over Baratz (US 5,742,596; Apr. 21, 1998) and Turock (US 6,243,373 B1; June 5, 2001).
2. Claim 9 stands rejected under 35 U.S.C. § 103(a) as obvious over Baratz and Turock, as evidenced by White (US 6,711,241 B1; Mar. 23, 2004).
3. Claims 1-12 and 14-22 stand rejected under 35 U.S.C. § 103(a) as obvious over Iwami (US 5,604,737; Feb. 18, 1997) and Baratz.
4. Claim 13 stands rejected under 35 U.S.C. § 103(a) as obvious over Iwami and Baratz, as evidenced by Lindgren (B. LINDGREN & LEIF JONSSON, ILLUSTRATED ISDN 1-6 to -9 (1991)).
5. Claims 1-3, 5, 6, 8-14, and 16-22 stand rejected under 35 U.S.C. § 103(a) as obvious over Jonas (US 2001/0040885 A1; Nov. 15, 2001) and Kubler (US 5,726,984; Mar. 10, 1998).
6. Claims 4 and 15 stand rejected under 35 U.S.C. § 103(a) as obvious over Jonas, Kubler, and Pepe (US 5,742,905; Apr. 21, 1998).

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7. Claim 7 stands rejected under 35 U.S.C. § 103(a) as obvious over Jonas, Kubler, and Iwami.

8. Claims 1–3, 5–14, and 16–22 stand rejected under 35 U.S.C. § 103(a) as obvious over Schindler (US 6,954,453 B1; Oct. 11, 2005), Merritt (Ian H. Merritt; *Providing Telephone Line Access to a Packet Voice Network*, Report No. ISI/RR-83-107, Information Sciences Institute, University of Southern California (1983)), and Kubler.

9. Claims 4 and 15 stand rejected under 35 U.S.C. § 103(a) as obvious over Schindler, Merritt, Kubler, and Pepe.

§ 103 Rejection—Iwami and Baratz

Claims 1–3, 5–10, 12, 14–17, and 19–22

The Examiner found that the communication server of Iwami, which determines whether the address input by a user is directed towards a communication terminal address or a telephone number, corresponds to the limitation “an IP versus another phone network discriminator.” (RAN 47–48, 102–103.) Requester agrees and argues that “Iwami discloses generally that a communication server 20 acts as a discriminator” and “determines whether an address of a called party is a communication terminal 10 on a LAN 1 or a telephone 2 on a public network 3.” (Requester Resp. Br. 11.) We agree with the Examiner’s determination.

Iwami relates to a voice communication system, in particular, “communication terminals connected through a communication network.” (Col. 1, ll. 6–8.) Figure 1 of Iwami illustrates a voice communication system, including communication terminals 10-1, 10-2 connected to Local

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

Area Network (LAN) 1 and telephone 2 connected to public network 3, such that LAN 1 and public network 3 are connected simultaneously to communication server 20. (Col. 7, ll. 1–8.) Iwami explains that “[t]he communication server [20] determines whether an address of the other party inputted by a user is a communication terminal address or a telephone number.” (Abstract.) Figure 5 of Iwami illustrates voice communication control processing performed by voice communication program 31 (col. 9, ll. 12–14) including “Step 124” in which “program 31 determines . . . whether or not the address of the other party with whom the user desires to speak is a telephone number consisting only of a sequence of numeric characters” (col. 9, ll. 29–33) such that “the user has requested a voice communication with a telephone 2 connected to the external public network 3” (col. 9, ll. 36–38). Otherwise, Iwami explains that “if the address of the other party inputted by the user is not a telephone number . . . the address of the other party can be regarded as the address of a communication terminal on the LAN 1.” (Col. 9, ll. 45–49.) Because communication server 20 of Iwami determines if the address of the other party is connected either through LAN 1 or public network 3, Iwami teaches the limitation “an IP versus another phone network discriminator.”

Patent Owner argues that “Iwami does not describe at least an IP versus another phone network discriminator.” (PO App. Br. 18.) In particular, Patent Owner argues that

Iwami describes how, at step 124, if the address of the other party (*i.e.*, the receiving party) is a telephone number consisting only of a sequence of numeric characters, this means that that the user (*i.e.*, the calling party) has requested a voice

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

communication with a telephone 2 connected to the external public network 3 through [the] communication server 20. (*Id.*; see also PO Reb. Br. 4.) Accordingly, Patent Owner argues, “[t]he user’s input of the numeric characters provides the information utilized by the communication server 20.” (*Id.* (emphasis omitted).) However, the claim language “an IP versus another phone network discriminator” is broad enough to encompass communication server 20 of Iwami, having program 31 which discriminates between a telephone number and an address for a terminal.

Patent Owner also argues “Iwami describes a system that . . . requires the user to discriminate between telephone or Internet lines” and accordingly, “Iwami teaches away from claims 1–12 and 14–22.” (PO App. Br. 18.) However other than providing a conclusory statement that Iwami teaches away from the claimed invention, Patent Owner does not provide any persuasive arguments as to how Iwami criticizes, discredits, or otherwise discourages the claimed “IP versus another phone network discriminator.” See *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Accordingly, we sustain the rejection of claims 1–3, 5–10, 12, 14–17, and 19–22 under 35 U.S.C. § 103(a).

Claim 4

The Examiner found that the fax component of Baratz corresponds to the limitation “wherein the originating phone device includes standard fax equipment,” as recited in dependent claim 4. (RAN 52 (citing RAN 22).) Requester agrees and argues that “Baratz discloses that the components shown coupled to system 10 may be implemented on the same host

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

computers or may be distributed throughout the network, indicating that the fax component 24 may be implemented within system 10 as an embodiment of Baratz.” (Requester Resp. Br. 14.) We agree with the Examiner’s determination.

Baratz “relates to a network based distributed Private Branch Exchange (PBX) system.” (Col. 1, ll. 5–6.) Figure 1 illustrates system 10, including telephony servers 44 for managing all system control processes (col. 4, ll. 8–10) and regular telephone sets 42 (col. 5, ll. 18–19). Figure 2 of Baratz illustrates system 10 coupled with automatic message distribution system 30 that delivers fax transmissions through fax component 24. (Col. 8, ll. 6–9.) Baratz explains the following:

The components/functions shown coupled to system 10 may be implemented on the same or different host computers. They do not necessarily have to be integral with the telephony server module but may be distributed throughout the network.

(Col. 7, ll. 6–10.) Because Baratz explains that fax component 24 can be distributed throughout the network, which includes coupling with regular telephone sets 42, Baratz teaches the limitation “wherein the originating phone device includes standard fax equipment.”

Patent Owner argues that “fax 24 and the automatic message distribution 30 are not a part of the system 10 or the network 37 within the system 10.” (PO App. Br. 19.) However, as discussed previously, Baratz explains that fax component 24 can be distributed throughout the network. (See col. 7, ll. 6–10.) Furthermore, Patent Owner’s arguments are not commensurate in scope with claim 11, because the claim does not expressly recite a location for the standard fax equipment.

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

Accordingly, we sustain the rejection of claim 4 under 35 U.S.C. § 103(a).

Claim 11

The Examiner found that the telephony server of Baratz, which is connected to Internet services, corresponds to the limitation “wherein the Internet phone server includes the destination number determination mechanism.” (RAN 55 (citing RAN 25).) Requester agrees and argues “Baratz says that a database in telephony server 44 is used ‘to support internal *and external* call capability’ . . . and that ‘network addresses (i.e. physical extensions) for both parties are retrieved from telephony server 44’ for both internal and external calls.” (Requester Reb. Br. 14.) We agree with the Examiner’s determination.

As discussed previously, Figure 1 of Baratz illustrates system 10, including telephony servers 44 for managing all system control processes. (Col. 4, ll. 8–10.) Baratz explains that “[t]o support internal and external call capability, telephony server 44 maintains a database of user records,” for example, an extension number. (Col. 6, ll. 16–19.) Because telephony server 44 includes a database of user records for making calls, Baratz teaches the limitation “wherein the Internet phone server includes the destination number determination mechanism.”

Patent Owner argues that “the Examiner incorrectly equated the database used to locate the computers 40 and the telephone sets 42 on the network 37 with the destination number determining mechanism that operates.” (PO App. Br. 19.) However, Patent Owner’s arguments are not

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

commensurate in scope with claim 11, because the claim does not exclude the claimed destination number determination mechanism from being stored on a network.

Accordingly, we sustain the rejection of claim 11 under 35 U.S.C. § 103(a).

Claim 18

The Examiner found that the voice communication server program on the communication server of Iwami corresponds to the limitation “wherein the Internet phone server comprises both a call receipt portion and a call delivery portion, and wherein the call delivery portion includes the discriminator.” (RAN 56–57.) Requester agrees and argues “[t]he communication server program clearly performs the functions of call receipt, for example accepting call requests from both telephones and communications terminals, and call delivery, for example transmitting voice packets to communication terminals and transmitting voice information to telephones.” (Requester Reb. Br. 14–15.) We agree with the Examiner’s determination.

Iwami explains that communication server 20 stores a voice communication server program 22 for voice communication control processing. (Col. 10, l. 66 to col. 11, l. 1.) Iwami further explains that:

The voice communication server program 22 is a program for accepting a call setting request from a telephone received from the public network communication controller 21 or a voice communication request from a communication terminal through the LAN communication controller 14 connected to the internal bus 19, editing voice packets

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

transmitted from the telephone into voice packets, transmitting the voice packets to the communication terminal, converting voice packets received from the communication terminal to voice information, and transmitting the voice information to the telephone, thus providing voice communication functions between the communication terminal connected to the LAN 1 and the telephone connected to the public network 3, similar to the conventional functions between telephones.

(Col. 11, ll. 4–17.) Because voice communication server program 22 of Iwami is stored on communication server 20 and provides voice communication functions between telephone 2 (connected to public network 3) and communication terminals 10-1, 10-2 (connected to LAN 1), Iwami teaches the limitation “wherein the Internet phone server comprises both a call receipt portion and a call delivery portion, and wherein the call delivery portion includes the discriminator.”

Patent Owner argues that “Iwami does not provide any discussion of the elements recited by claim 18.” (PO App. Br. 20.) However, other than making a conclusory statement, Patent Owner has not provided a sufficient explanation as to why dependent claim 18 is patentable over the combination of Iwami and Baratz.

Accordingly, we sustain the rejection of claim 18 under 35 U.S.C. § 103(a).

§ 103 Rejection—Iwami, Baratz, and Lindgren

Although Patent Owner nominally argues the rejection of dependent claim 13 separately (PO App. Br. 20), the arguments presented do not point out with particularity or explain why the limitations of this dependent claim is separately patentable. Instead, Patent Owner summarily alleges that

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

“there is nothing in Lindgren that may be said to describe or suggest, among other things, an apparatus including an apparatus including IP versus another phone network discriminator” and “[g]iven that Lindgren does not cure the deficiencies noted with respect to Iwami and Baratz, the combination of Lindgren with Iwami and Baratz cannot be said to render obvious claim 13.” (*Id.*) We are not persuaded by these arguments for the reasons discussed with respect to claim 1, from which claim 13 depends. Accordingly, we sustain this rejection.

Other § 103 Rejections

We do not reach the additional cumulative rejections of claims 1–22 under 35 U.S.C. § 103(a) as obvious over various combinations of Baratz, Turock, White, Jonas, Kubler, Pepe, Iwami, Schindler, and Merritt. Affirmance of the obviousness based rejections discussed previously renders it unnecessary to reach the remaining obviousness rejections, as all of pending claims have been addressed and found unpatentable.

DECISION

The Examiner’s decision to reject claims 1–22 under U.S.C. § 103(a) is affirmed.

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. § 1.956. See 37 C.F.R. § 41.79.

AFFIRMED

mls

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

PATENT OWNER:

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Orange Beach, AL 36561

THIRD PARTY REQUESTER:

HAYNES AND BOONE, LLP
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

FORM 5. Petition for Review or Notice of Appeal of an Order or Decision of an AGENCY, BOARD, COMMISSION, OFFICE OR BUREAU.

United States Court of Appeals for Federal Circuit

Bear Creek Technologies, Inc.

Petitioner or Appellant,

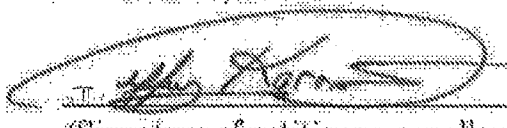
v.

PETITION FOR REVIEW

Cisco Systems, Inc.

Respondent or Appellee.

Bear Creek Technologies, Inc. (name all parties* bringing the petition or appeal) hereby petition/appeal the court for review of the Decision on Appeal (No. 2015-6987) (describe the order or decision and include decision number) of the Patent Trial and Appeal Board (name the agency, board, office or bureau) entered on December 29 2015 (date). The order or decision was received on December 29 2015 (date).


(Signature of petitioner, appellant or attorney)

Jeffrey D. Karcoski
Attorney for Bear Creek Technologies, Inc.
1717 K Street, N.W., Suite 900
Washington, DC 20006
(202) 349-9868

(Address and phone number of petitioner, appellant or attorney)

*See Fed. R. App. P. 15 for permissible ways of identifying petitioners.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/002,190	09/12/2012	7889722	BCT-P001USC3-R3	4394

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12/29/2015

EXAMINER

LEE, CHRISTOPHER E

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12/29/2015

PAPER

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.
Requester and Respondent

v.

BEAR CREEK TECHNOLOGIES, INC.
Patent Owner and Appellant

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2
Technology Center 3900

Before MARC S. HOFF, DAVID M. KOHUT, and ERIC B. CHEN,
Administrative Patent Judges.

CHEN, *Administrative Patent Judge.*

DECISION ON APPEAL

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

Patent Owner Bear Creek Technologies, Inc. appeals under 35 U.S.C. § 134(b) and 35 U.S.C. § 315(a) (pre-AIA) the Examiner's final decision to reject claims 1–22.

An oral hearing was held on November 10, 2015, with both parties in attendance. The record includes a written transcript of the oral hearing.

Third-Party Requester Cisco Systems, Inc. urges that the Examiner's decision be affirmed.

We affirm.

STATEMENT OF THE CASE

U.S. Patent No. 7,889,722 B2 ("722 patent"), entitled "System for Interconnecting Standard Telephony Communications Equipment to Internet Protocol Networks," issued February 15, 2011 to Joseph B. Thompson, based on Application No. 11/253,129, filed October 18, 2005, which is said to be a continuation of Application No. 10/770,808, filed February 3, 2004, now U.S. Patent No. 6,985,494 B2, issued January 10, 2006, which is said to be a continuation of Application No. 10/279,645, filed October 24, 2002, now abandoned, which is said to be a continuation of Application No. 08/812,745, filed March 6, 1997, now abandoned.

The '722 patent is also said to claim priority to provisional Application No. 60/012,896, filed on March 6, 1996 and provisional Application No. 60/013,240, filed on March 11, 1996.

The '722 patent is assigned to Bear Creek Technologies, Inc., the real party in interest.

Appeal 2015-006387
Reexamination Control 95/002,190
Patent 7,889,722 B2

Related Litigation

The '722 patent is or has been involved in numerous litigations, as summarized in Patent Owner's Appeal Brief. (PO App. Br. 1-2.)

The Claims

Independent claim 1 is exemplary, with disputed limitations in italics:

1. Apparatus comprising:
 - an Internet phone server capable of being in communication with an originating phone device, the originating phone device being capable of both dialing a given destination number of a given destination device and thereby initiating a given call between the originating phone device and the given destination device, an auditory dial tone being caused at the originating phone device when the originating phone device is in an off-hook state and operatively connected to the Internet phone server, the given call including transmission of transmitted media between the originating phone device and the given destination device;
 - a first media converter configured to convert the transmitted media for the given call received from the originating phone device, to transmitted IP addressed media;
 - a destination number determination mechanism configured to determine a given destination number of the given call placed by the originating phone device;
 - an IP versus another phone network discriminator* configured to determine, after the transmitted media is converted by the first media converter to the transmitted IP addressed media, whether a given destination phone device addressed by the given destination number resides on an IP addressed network, for which the transmitted IP addressed media is converted by the first media converter, or resides on another phone network;
 - a second media converter configured to convert the transmitted IP addressed media of the given call to another network signal suitable for another phone network when the discriminator determines

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that the given destination number resides on the other phone network;
and

a communication mechanism configured to connect the given call over an Internet connection without converting the transmitted IP addressed media of the given call to the other network signal, when the discriminator determines that the given destination device addressed by the given destination number resides on the IP addressed network.

The Rejections

Patent Owner appeals the Examiner's decision to reject all the pending claims, as follows:

1. Claims 1-8 and 10-22 stand rejected under 35 U.S.C. § 103(a) as obvious over Baratz (US 5,742,596; Apr. 21, 1998) and Turock (US 6,243,373 B1; June 5, 2001).
2. Claim 9 stands rejected under 35 U.S.C. § 103(a) as obvious over Baratz and Turock, as evidenced by White (US 6,711,241 B1; Mar. 23, 2004).
3. Claims 1-12 and 14-22 stand rejected under 35 U.S.C. § 103(a) as obvious over Iwami (US 5,604,737; Feb. 18, 1997) and Baratz.
4. Claim 13 stands rejected under 35 U.S.C. § 103(a) as obvious over Iwami and Baratz, as evidenced by Lindgren (B. LINDGREN & LEIF JONSSON, ILLUSTRATED ISDN 1-6 to -9 (1991)).
5. Claims 1-3, 5, 6, 8-14, and 16-22 stand rejected under 35 U.S.C. § 103(a) as obvious over Jonas (US 2001/0040885 A1; Nov. 15, 2001) and Kubler (US 5,726,984; Mar. 10, 1998).
6. Claims 4 and 15 stand rejected under 35 U.S.C. § 103(a) as obvious over Jonas, Kubler, and Pepe (US 5,742,905; Apr. 21, 1998).

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7. Claim 7 stands rejected under 35 U.S.C. § 103(a) as obvious over Jonas, Kubler, and Iwami.

8. Claims 1–3, 5–14, and 16–22 stand rejected under 35 U.S.C. § 103(a) as obvious over Schindler (US 6,954,453 B1; Oct. 11, 2005), Merritt (Ian H. Merritt, *Providing Telephone Line Access to a Packet Voice Network*, Report No. ISI/RR-83-107, Information Sciences Institute, University of Southern California (1983)), and Kubler.

9. Claims 4 and 15 stand rejected under 35 U.S.C. § 103(a) as obvious over Schindler, Merritt, Kubler, and Pepe.

§ 103 Rejection—Iwami and Baratz

Claims 1–3, 5–10, 12, 14–17, and 19–22

The Examiner found that the communication server of Iwami, which determines whether the address input by a user is directed towards a communication terminal address or a telephone number, corresponds to the limitation “an IP versus another phone network discriminator.” (RAN 47–48, 102–103.) Requester agrees and argues that “Iwami discloses generally that a communication server 20 acts as a discriminator” and “determines whether an address of a called party is a communication terminal 10 on a LAN 1 or a telephone 2 on a public network 3.” (Requester Resp. Br. 11.) We agree with the Examiner’s determination.

Iwami relates to a voice communication system, in particular, “communication terminals connected through a communication network.” (Col. 1, ll. 6–8.) Figure 1 of Iwami illustrates a voice communication system, including communication terminals 10-1, 10-2 connected to Local

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Area Network (LAN) 1 and telephone 2 connected to public network 3, such that LAN 1 and public network 3 are connected simultaneously to communication server 20. (Col. 7, ll. 1–8.) Iwami explains that “[t]he communication server [20] determines whether an address of the other party inputted by a user is a communication terminal address or a telephone number.” (Abstract.) Figure 5 of Iwami illustrates voice communication control processing performed by voice communication program 31 (col. 9, ll. 12–14) including “Step 124” in which “program 31 determines . . . whether or not the address of the other party with whom the user desires to speak is a telephone number consisting only of a sequence of numeric characters” (col. 9, ll. 29–33) such that “the user has requested a voice communication with a telephone 2 connected to the external public network 3” (col. 9, ll. 36–38). Otherwise, Iwami explains that “if the address of the other party inputted by the user is not a telephone number . . . the address of the other party can be regarded as the address of a communication terminal on the LAN 1.” (Col. 9, ll. 45–49.) Because communication server 20 of Iwami determines if the address of the other party is connected either through LAN 1 or public network 3, Iwami teaches the limitation “an IP versus another phone network discriminator.”

Patent Owner argues that “Iwami does not describe at least an IP versus another phone network discriminator.” (PO App. Br. 18.) In particular, Patent Owner argues that

Iwami describes how, at step 124, if the address of the other party (*i.e.*, the receiving party) is a telephone number consisting only of a sequence of numeric characters, this means that that the user (*i.e.*, the calling party) has requested a voice

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communication with a telephone 2 connected to the external public network 3 through [the] communication server 20. (*Id.*; see also PO Reb. Br. 4.) Accordingly, Patent Owner argues, “[t]he user’s input of the numeric characters provides the information utilized by the communication server 20.” (*Id.* (emphasis omitted).) However, the claim language “an IP versus another phone network discriminator” is broad enough to encompass communication server 20 of Iwami, having program 31 which discriminates between a telephone number and an address for a terminal.

Patent Owner also argues “Iwami describes a system that . . . requires the user to discriminate between telephone or Internet lines” and accordingly, “Iwami teaches away from claims 1–12 and 14–22.” (PO App. Br. 18.) However other than providing a conclusory statement that Iwami teaches away from the claimed invention, Patent Owner does not provide any persuasive arguments as to how Iwami criticizes, discredits, or otherwise discourages the claimed “IP versus another phone network discriminator.” See *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Accordingly, we sustain the rejection of claims 1–3, 5–10, 12, 14–17, and 19–22 under 35 U.S.C. § 103(a).

Claim 4

The Examiner found that the fax component of Baratz corresponds to the limitation “wherein the originating phone device includes standard fax equipment,” as recited in dependent claim 4. (RAN 52 (citing RAN 22).) Requester agrees and argues that “Baratz discloses that the components shown coupled to system 10 may be implemented on the same host

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computers or may be distributed throughout the network, indicating that the fax component 24 may be implemented within system 10 as an embodiment of Baratz.” (Requester Resp. Br. 14.) We agree with the Examiner’s determination.

Baratz “relates to a network based distributed Private Branch Exchange (PBX) system.” (Col. 1, ll. 5–6.) Figure 1 illustrates system 10, including telephony servers 44 for managing all system control processes (col. 4, ll. 8–10) and regular telephone sets 42 (col. 5, ll. 18–19). Figure 2 of Baratz illustrates system 10 coupled with automatic message distribution system 30 that delivers fax transmissions through fax component 24. (Col. 8, ll. 6–9.) Baratz explains the following:

The components/functions shown coupled to system 10 may be implemented on the same or different host computers. They do not necessarily have to be integral with the telephony server module but may be distributed throughout the network.

(Col. 7, ll. 6–10.) Because Baratz explains that fax component 24 can be distributed throughout the network, which includes coupling with regular telephone sets 42, Baratz teaches the limitation “wherein the originating phone device includes standard fax equipment.”

Patent Owner argues that “fax 24 and the automatic message distribution 30 are not a part of the system 10 or the network 37 within the system 10.” (PO App. Br. 19.) However, as discussed previously, Baratz explains that fax component 24 can be distributed throughout the network. (See col. 7, ll. 6–10.) Furthermore, Patent Owner’s arguments are not commensurate in scope with claim 11, because the claim does not expressly recite a location for the standard fax equipment.

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Accordingly, we sustain the rejection of claim 4 under 35 U.S.C.
§ 103(a).

Claim 11

The Examiner found that the telephony server of Baratz, which is connected to Internet services, corresponds to the limitation “wherein the Internet phone server includes the destination number determination mechanism.” (RAN 55 (citing RAN 25).) Requester agrees and argues “Baratz says that a database in telephony server 44 is used ‘to support internal *and external* call capability’ . . . and that ‘network addresses (i.e. physical extensions) for both parties are retrieved from telephony server 44’ for both internal and external calls.” (Requester Reb. Br. 14.) We agree with the Examiner’s determination.

As discussed previously, Figure 1 of Baratz illustrates system-10, including telephony servers 44 for managing all system control processes. (Col. 4, ll. 8–10.) Baratz explains that “[t]o support internal and external call capability, telephony server 44 maintains a database of user records,” for example, an extension number. (Col. 6, ll. 16–19.) Because telephony server 44 includes a database of user records for making calls, Baratz teaches the limitation “wherein the Internet phone server includes the destination number determination mechanism.”

Patent Owner argues that “the Examiner incorrectly equated the database used to locate the computers 40 and the telephone sets 42 on the network 37 with the destination number determining mechanism that operates.” (PO App. Br. 19.) However, Patent Owner’s arguments are not

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commensurate in scope with claim 11, because the claim does not exclude the claimed destination number determination mechanism from being stored on a network.

Accordingly, we sustain the rejection of claim 11 under 35 U.S.C. § 103(a).

Claim 18

The Examiner found that the voice communication server program on the communication server of Iwami corresponds to the limitation “wherein the Internet phone server comprises both a call receipt portion and a call delivery portion, and wherein the call delivery portion includes the discriminator.” (RAN 56–57.) Requester agrees and argues “[t]he communication server program clearly performs the functions of call receipt, for example accepting call requests from both telephones and communications terminals, and call delivery, for example transmitting voice packets to communication terminals and transmitting voice information to telephones.” (Requester Reb. Br. 14–15.) We agree with the Examiner’s determination.

Iwami explains that communication server 20 stores a voice communication server program 22 for voice communication control processing. (Col. 10, l. 66 to col. 11, l. 1.) Iwami further explains that:

The voice communication server program 22 is a program for accepting a call setting request from a telephone received from the public network communication controller 21 or a voice communication request from a communication terminal through the LAN communication controller 14 connected to the internal bus 19, editing voice packets

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transmitted from the telephone into voice packets, transmitting the voice packets to the communication terminal, converting voice packets received from the communication terminal to voice information, and transmitting the voice information to the telephone, thus providing voice communication functions between the communication terminal connected to the LAN 1 and the telephone connected to the public network 3, similar to the conventional functions between telephones.

(Col. 11, ll. 4–17.) Because voice communication server program 22 of Iwami is stored on communication server 20 and provides voice communication functions between telephone 2 (connected to public network 3) and communication terminals 10-1, 10-2 (connected to LAN 1), Iwami teaches the limitation “wherein the Internet phone server comprises both a call receipt portion and a call delivery portion, and wherein the call delivery portion includes the discriminator.”

Patent Owner argues that “Iwami does not provide any discussion of the elements recited by claim 18.” (PO App. Br. 20.) However, other than making a conclusory statement, Patent Owner has not provided a sufficient explanation as to why dependent claim 18 is patentable over the combination of Iwami and Baratz.

Accordingly, we sustain the rejection of claim 18 under 35 U.S.C. § 103(a).

§ 103 Rejection— Iwami, Baratz, and Lindgren

Although Patent Owner nominally argues the rejection of dependent claim 13 separately (PO App. Br. 20), the arguments presented do not point out with particularity or explain why the limitations of this dependent claim is separately patentable. Instead, Patent Owner summarily alleges that

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“there is nothing in Lindgren that may be said to describe or suggest, among other things, an apparatus including an apparatus including IP versus another phone network discriminator” and “[g]iven that Lindgren does not cure the deficiencies noted with respect to Iwami and Baratz, the combination of Lindgren with Iwami and Baratz cannot be said to render obvious claim 13.” (*Id.*) We are not persuaded by these arguments for the reasons discussed with respect to claim 1, from which claim 13 depends. Accordingly, we sustain this rejection.

Other § 103 Rejections

We do not reach the additional cumulative rejections of claims 1–22 under 35 U.S.C. § 103(a) as obvious over various combinations of Baratz, Turock, White, Jonas, Kubler, Pepe, Iwami, Schindler, and Merritt. Affirmance of the obviousness based rejections discussed previously renders it unnecessary to reach the remaining obviousness rejections, as all of pending claims have been addressed and found unpatentable.

DECISION

The Examiner’s decision to reject claims 1–22 under U.S.C. § 103(a) is affirmed.

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. § 1.956. See 37 C.F.R. § 41.79.

AFFIRMED

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